

Appl. No. 10/749,045
Amdt. Dated April 4, 2007
Reply to Office Action of March 9, 2007

APR 04 2007

REMARKS

The Remarks are in response to the Final Office Action mailed March 9, 2007. Applicant appreciates the Examiner's careful review and consideration of the present application.

Claim Rejections Under 35 U.S.C. 103

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishigaki (US 6,776,931).

Claim 10 recites in part:

“a second plate having a side wall opposite to the side wall of the first plate, the side wall of the second plate being non-parallel to the side wall of the first plate;

a cavity defined between the first plate and the second plate, the cavity being one of wedge-shaped and papilionaceous shape in cross-section; and

a passageway provided in the first plate for cooling and solidifying molten resin injected into the cavity;

wherein the fluid passageway is arranged in a plane non-parallel with the side wall of the first plate and parallel with the side wall of the second plate.” (Emphasis added.)

Claim 20, as originally filed, recites in part:

“said plurality of passageways are arranged in a plane with regard to the oblique side wall in a non-parallel manner.” (Emphasis added.)

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In rejecting claims 10 and 20, the Examiner states that: if it is already known to have the cooling channels parallel to each other, then one of ordinary skill in the art would probably have considered it expedient to maintain the cooling channels in their parallel relationship and simply modify the side plates of the molds to arrive at the desired cavity shape.

In response to the rejection of claims 10 and 20, Applicant respectfully traverses this rejection, and submits that claims 10 and 20 are unobvious over Nishigaki or any other cited reference, taken alone or in combination, and thus should be allowed.

Applicant respectfully submits that **the Examiner's current argument implicitly relies on case law (e.g., design choice; matter of routine experimentation) to reject an element/limitation of the claim for which Applicant has an expressed criticality --- yielding uniform heat distribution to avoid stress formation in the molded product (see, e.g., Paragraphs [0008] and [0022]).**

MPEP §2144.04, first paragraph, states, in part:

"If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection."

As such, an Examiner, as set forth in the MPEP, cannot rely solely on one or more case-law based arguments to properly establish the obviousness of the missing feature, if that feature is critical to the present invention.

Additionally, Applicant submits that there is **nothing in the Nishigaki that would fairly suggest particularly arranging the fluid passageway in such manner that "the fluid passageway is arranged in a plane non-parallel with the side wall of the first plate and parallel with the side wall of the second plate", in the manner required in claim 10. "Obviousness can only be established by combining or modifying the teachings of the prior art**

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to produce the claimed invention where there is some teaching, suggestion, or motivation to do so." *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)

With respect to claim 20, more specifically, Nishigaki teaches a mold wherein the fluid passageways 29 (labeled in FIG. 3) are arranged in a plane parallel to the side wall of the cavity plate 28. Consistent with the argument presented above with respect to claim 10, even in a situation in which a wedge shape is to be produced, Nishigaki does not particularly disclose or suggest that any of the fluid passageways 29 would be non-parallel to an oblique side wall. Essentially, Nishigaki fails to teach or suggest the subject matter of claim 20.

Finally, even if the reference could be modified to produce a wedge-shaped light guide plate, Nishigaki does not render the resultant modification obvious because Nishigaki fails to suggest the desirability of the modification. As stated in MPEP §2143.01, "the prior art must suggest the desirability of the claimed invention", "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness", and "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In particular, no motivation is provided to specifically align the passageways non-parallel to an oblique side wall, as per claim 20.

For at least the above reason, Applicant submits that claims 10 and 20 are novel, unobvious, and patentable under 35 U.S.C. §103 over Nishigaki and the other cited reference. Reconsideration and removal of the rejection of claims 10 and 20 are respectfully requested.

Claims 11-19 depend directly or indirectly on claim 10, which is asserted to be in condition for allowance under §103 as detailed above. Accordingly, Applicant submits that claims 11-19 are also unobvious and

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patentable under 35 U.S.C. §103 over Nishigaki and the other cited reference.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishigaki in view of Choi et al. (US 6,699,409).

In response to the rejection of claim 1, for similar reasons presented above with respect to claim 10, Applicant respectfully traverses this rejection.

Claim 1 recites in part:

“wherein the side wall of the first plate faces the side wall of the second plate in a **non-parallel manner**,

...

cooling the molten resin so that it solidifies by means of a refrigerant filled in a fluid passageway, wherein the fluid passageway is provided in the first plate, and is arranged in a plane with regard to the side wall of the first plate in a **non-parallel manner** and with regard to the side wall of the second plate in a parallel manner.” (Emphasis added.)

Applicant submits that claim 1 is unobvious over Nishigaki in view of Choi et al or any other cited reference, taken alone or in combination, and thus should be allowed. Briefly stated, Choi et al. is unable to overcome the shortcomings set forth above with respect to Nishigaki et al.

Claims 2-9 depend directly or indirectly on claim 1, which is asserted to be in condition for allowance under §103 as detailed above. Accordingly, Applicant submits that claims 2-9 are also unobvious and patentable under 35 U.S.C. §103 over Nishigaki in view of Choi et al and the other cited

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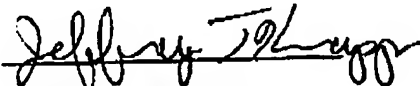
reference.

The arguments set forth with respect to independent claims 1, 10, and 20, in the Response submitted Jan. 2, 2007, are deemed pertinent by Applicant and are herein incorporated by reference thereto.

In view of the above remarks, the subject application is believed to be in a condition for allowance, and an action to such effect is earnestly solicited.

Respectfully submitted,

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